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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/604,001      06/26/2000      Peter Hossel      50105      2632

26474      7590      09/10/2002

KEIL & WEINKAUF  
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WASHINGTON, DC 20036

EXAMINER
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FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 09/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/604,001

Applicant(s)

HOSSEL ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Examiner acknowledges request for extension of time and request for continued examination under 37 CFR 1.114 filed 08/19/02. Claims 1-14 are pending.

#### ***Claim Objections***

Amended claim 3 refers to formula (II) with out providing the formula in the claim. It appears that the formula may have been inadvertently left behind when the claim was amended. Original claim 3 provided formula (II). Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Uhl et al. (US 5,219,969).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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Uhl discloses water-in-oil emulsion and oil-in-water emulsion polymeric preparation wherein the preparation comprises divinylethyleneurea, N-vinylimidazole and 2, 2'-azobis (2-amidinopropane) dihydrochloride, and the polymerization of the monomers takes place by free radical process (abstract, column 4, lines 11-65, columns 9 and 10 and claims 1-5). Future intended use is not critical in composition claims. Future intended use is not critical in a composition claim. Thus, the teachings of Uhl meet the limitations of the claims.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tropsch et al. (US 5,869,032) in view of Kumar et al. (US 5,468,477).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in

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the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Tropsch discloses a polymeric preparation that can be used in cosmetic compositions such as liquid soaps, body lotions, aftershaves, face lotion and other liquid formulation for skin. The polymeric preparation of Tropsch comprises 1-vinylimidazole, quaternized 1-vinylimidazole, N-vinylcaprolactam, N-vinylpyrrolidone, 3-methyl-1-vinylimidazolium methylsulfate, 2,2'-azobis(2-amidinopropane) dihydrochloride and polymerization of the preparation takes place by free radical polymerization. Furthermore, the preparation contains perfume oils, emulsifiers, preservatives, collagen and vitamins. See abstract, columns 1-4, formulations 1-10 and claims 1, 2, and 11-13. The composition of Tropsch is inherently an emulsion. The polymeric preparation of Tropsch comprises 1-vinylimidazole, quaternized 1-vinylimidazole, N-vinylcaprolactam, N-vinylpyrrolidone, 3-methyl-1-vinylimidazolium methylsulfate, 2,2'-azobis(2-amidinopropane) dihydrochloride and polymerization of the preparation takes place by free radical polymerization. Furthermore, the preparation contains perfume oils, emulsifiers, preservatives, collagen and vitamins. The composition of Tropsch et al. further comprises monomers selected from the group consisting of C<sub>1</sub>-C<sub>12</sub>-esters of acrylic or methacrylic acid, acrylamides and methacrylamides. See abstract, columns 1-4, formulations 1-10 and claims 1, 2, and 11-13. Monomers of acrylic and methacrylic esters are capable of acting

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as crosslinkers (compare page 8, lines 8-10 of applicants' specification). Tropsch in column 2, lines 50-52 teaches hydroxyalkyl (meth) acrylates or alkylethylene glycol (meth) acrylates that have 1-50 ethylene glycol units in the monomeric unit. Glycol is a dihydric alcohol.

Tropsch clearly teaches the preparation of the application except that it does not teach the presence of a monomer that has at least two ethylenically unsaturated non-conjugated double bonds.

But Kumar teaches a cosmetic composition comprising graft copolymer prepared by free radical polymerization of a silicone chain and vinyl monomers and examples of vinyl monomers applicable in Kumar are vinyl ethers and vinyl esters (column 4, lines 7-28, column 8, lines 20-28 and column 15, lines 22-44).

Kumar and Tropsch teach compositions that are used for the same purpose. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare a third composition that contains the vinyl monomers of Kumar in the composition/preparation of Tropsch because, "it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose....[T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,869,032 (Tropsch et al.) in view of Kumar et al (US 5,468,477). Both Tropsch and Kumar teach cosmetic composition. The difference between Tropsch and the application is that Tropsch does not teach monomers that have at least two ethylenically unsaturated non-conjugated double bonds. But Kumar teaches a cosmetic composition that has monomer units of vinyl ethers or vinyl esters. "it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose....[T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

**Suggestion:** It is suggested that abbreviations W/O and O/W in claims 10 and 11 be replaced with water-in-oil or oil-in-water. It is also suggested that applicants use in the claims --selected from the group consisting of --- instead of "chosen."

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. Shih (US 5,321,110) teaches a cationic polymer composition comprising vinylpyrrolidone, quaternized amino alkyl acrylamido or acrylate, triallylamine, N,N'-

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divinylimidazolidine and polymer formation from 1-99% by weight of each monomer (column 1, lines 8-65, column 4, lines 63-68, column 5, lines 45-50 and claims 1-20).

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

In requesting continued examination, applicants agree that Uhl teaches 50 to 99 parts by weight of acrylic acid and /or methacrylic acid and that there is no overlap between the disclosed amount and that recited in the claims. Examiner agrees with applicants that part c of claim 1 is optional but the claim language does not exclude those monomers.

Applicants also state that to overcome Best, applicants presented a comparative test data at page 27 to demonstrate that skin crème A with cross-linking agent is superior to skin crème without cross-linking agent. However, it is noted that the cross-linking agent is optional in the generic claims and it is unclear how the comparative data derived for a monomer that is optional. Secondly, the comparative data on pages 26 and 27 of the instant specification does not refer to the composition of Uhl.

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification including the claims.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Blessing Fubara  
September 7, 2002

  
THURMAN K. PAGE  
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